

23 MAY 2003



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In re Application of	:	DECISION ON RENEWED
LEPPARD et al.	:	
Application No.: 09/856,769	:	PETITION UNDER
PCT No.: PCT/EP99/08968	:	
Int. Filing Date: 20 November 1999	:	37 CFR 1.47(a)
Priority Date: 30 November 1998	:	
Attorney Docket No.: A-21884/A/PCT	:	
For: PROCESS FOR THE PREPARATION OF	:	
ACYLPHOSPHINES, ACYL OXIDES AND	:	
ACYL SULFIDES	:	

This is a decision on applicants' "RENEWED PETITION UNDER RULE 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 09 December 2002.

### **BACKGROUND**

On 20 November 1999, applicants filed international application PCT/EP99/08968, which claimed a priority date of 30 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 30 May 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 May 2001.

On 24 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic filing fee and a copy of the international application.

On 05 July 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a two-month extendable period for reply.

On 14 January 2002, applicants submitted a petition under 37 CFR 1.47(a), which was

accompanied by, *inter alia*: a petition/fee for a four-month extension of time; the surcharge under 37 CFR 1.492(e); a pair of declarations of inventors which together were executed by all of the inventors except Rene Kaeser; a declaration of facts by Hans-Peter Wittlin; and the requisite petition fee.

On 10 May 2002, the USPTO mailed a decision dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that the declaration of Mr. Wittlin stated that there was an express oral refusal to sign the declaration but Mr. Wittlin was not present when this oral refusal was made. It was also noted that it was not clear whether the documents sent to the non-signing inventor included the specification, drawings, and claims.

On 09 December 2002, applicants submitted the instant "RENEWED PETITION UNDER RULE 1.47(a)", which was accompanied by, *inter alia*, a second declaration of facts by Hans-Peter Wittlin, a copy of a letter sent by Mr. Wittlin to Mr. Kaeser, and an English translation of the letter sent by Mr. Wittlin to Mr. Kaeser.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The decision mailed 10 May 2002 indicated that items (1), (3) and (4) had been met. The decision mailed 10 May 2002 also indicated item (2) had not been met regarding the non-signing joint inventor Mr. Kaeser. The steps enumerated in the further declaration of facts by Mr. Wittlin and the translation of the letter sent by Mr. Wittlin to Mr. Kaeser submitted 09 December 2002 are sufficient to establish that Mr. Kaeser refuses to execute the application and that Mr. Kaeser was presented with a copy of the application including the specification, drawings, and claims.

### CONCLUSION

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

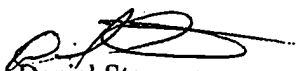
Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded

to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. 371(c) date of 14 January 2002.



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In re Application of  
LEPPARD et al.

Application No.: 09/856,769

PCT No.: PCT/EP99/08968

Int. Filing Date: 20 November 1999

Priority Date: 30 November 1998

Attorney Docket No.: A-21884/A/PCT

For: PROCESS FOR THE PREPARATION OF ACYLPHOSPHINES, ACYL OXIDES AND  
ACYL SULFIDES

Dear Mr. Kaeser:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

A handwritten signature in black ink, appearing to read "Daniel Stemmer".

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